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EXAMINER

PHAN, JOSEPH T

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/633,356	Applicant(s) ROMEO ET AL.	
	Examiner Joseph T. Phan	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-10, 12-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-10, 12-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 04/28/2008 have been fully considered but they are not persuasive.

Regarding claim 21, Applicant argues the secondary reference, Enzmann, does not disclose a conventional home telephone as applicant has amended. However it is noted that the Examiner does not use Enzmann to disclose the recited 'conventional home telephone' as the primary reference, Uppaluru col.6 lines 7-16, already discloses it. The Examiner merely uses Enzmann to disclose the feature of 'prompting the user to select between a voice call and internet access' which Enzmann discloses as shown below.

Regarding claim 22, Applicant argues that Enzmann does not disclose 'receiving an incoming calling card call from the conventional telephone to an internet service provider'. It is again noted that the Examiner does not use Enzmann to disclose this recited feature as the primary reference, Uppaluru col.9 lines 57-64, already discloses it. The Examiner merely uses Enzmann to disclose the feature of 'prompting the user to select between a voice call and internet access' which Enzmann discloses as shown below.

In view of the above, the Examiner maintains the rejection until amendments are made to read away from the prior arts of record below.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2614

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 3-10, 12-19, 21 and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Uppaluru, Patent #5,915,001 in view of Enzmann, Patent #6,320,946.

Regarding claim 21, Uppaluru teaches a method of providing a telephone user with access to Internet content, comprising the steps of:

responsive to an interactive voice response (IVR) system receiving a calling card call from a conventional home telephone via the PSTN(col.15 lines 41-45), completing a telephone call to a destination telephone number(col.6 lines 6-29 and col.9 lines 57-64), responsive to determining the user selected Internet access(col.2 lines 7-10, col.3 lines 41-48, and col.19 lines 1-23), performing the following steps: receiving IVR input from the user representing a password(col.3 lines 1-17 and col.19 lines 1-23);

providing the user with a preference selection menu(col.19 lines 1-23);

providing the user with a content selection menu(col.19 lines 1-23);

receiving IVR input from the user representing Internet content selection(col.2 lines 7-10, col.3 lines 41-48, and col.19 lines 1-23);

Art Unit: 2614

communicating the content selection to an Internet server via modemless communications(Fig.1, col.2 lines 22-41);

translating the Internet content from text format to audio data(col.8 lines 16-24 and col.17 line 59-col.18 line 28); and transmitting the audio data to the conventional telephone via the PSTN(col.8 lines 16-24 and col.17 line 59-col.18 line 28).

Uppaluru does not specifically teach prompting the user to select between a voice call and internet access; and determining the user selected the voice call,

In the same field of endeavor, Enzmann teaches prompting the user to select between a voice call and internet access and responsive to determining the user selected the voice call, completing the telephone call to a destination telephone number(Enzmann abstract, col.2 lines 6-17, col.7 lines 3-15, and col.10 lines 23-39). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system prompts of Uppaluru(col.9 lines 56-67 and col.15 lines 41-60) to initially include prompting the user to select between a voice call and internet access as obvious and further disclosed by Enzmann. Uppaluru's system already includes prompting the user and is able to determine selections so adding prompting the user to select between a voice call and internet access is an obvious design choice as Uppaluru's system is capable of making voice calls and accessing the internet. This would further provide access to telephony calls with the calling card so that Uppaluru's user can access both internet and regular voice calls via the same access card. This will also simplify billing since the user is charged for both services under one account. It is further noted that it is understood that the conventional home telephones coupled with the PSTN disclosed in Uppaluru

col.6 lines 6-29 are able to complete telephone call connections.

Regarding claim 3, Uppaluru in view of Enzmann teaches the method of Claim 21, wherein the telephone call is a wire line call from the user(Uppaluru col.6 lines 6-22).

Regarding claim 4, Uppaluru in view of Enzmann teaches the method of Claim 21, wherein the telephone call is a wireless call from the user(Uppaluru col.6 lines 6-22).

Regarding claim 5, Uppaluru in view of Enzmann teaches the method of Claim 21. Uppaluru does not specifically teaches wherein the text format is XML format.

In the same field of endeavor, Enzmann teaches wherein the text format is XML format (col. 9, lines 12-28).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the format of Uppaluru to include XML as taught by Enzmann so that the web site creator can create customized tags that are specific for them and their customers and also to be able to retrieve web page documents that are requested by a calling party of Uppaluru.

Regarding claim 6, Uppaluru in view of Enzmann teaches the the IVR input is telephone keypad input(Uppaluru col.19 lines 6-7).

Regarding claim 7, Uppaluru in view of Enzmann teaches the method of Claim 21, wherein the IVR input is voice input(Uppaluru col.19 lines 6-7).

Regarding claim 8, Uppaluru in view of Enzmann teaches the method of Claim 21, wherein for Internet access, the step of receiving IVR input is followed by the steps of providing an IVR menu of Internet content selections and of receiving IVR input representing an Internet content selection(Uppaluru col.19 lines 1-23).

Regarding claim 9, Uppaluru in view of Enzmann teaches the method of Claim 21, wherein the Internet content includes email messages(Uppaluru col.9 lines 48-56).

Regarding claim 10, Uppaluru in view of Enzmann teaches the method of Claim 21, further comprising the steps of presenting the user with an option to change preferences and of receiving IVR input representing one or more preference settings(Uppaluru fig.5 and col.2 lines 42-52).

Regarding claim 22, Uppaluru teaches a system for enabling Internet access to a user of a conventional telephone and the public switched telephone network (PSTN)(abstract, Fig.1 and col.6 lines 6-22), comprising an interactive voice response (IVR) system operable to: receive an incoming calling card call from the conventional telephone to an internet service provider(*col.9 lines 57-64 and col.15 lines 41-45; Uppaluru's service provider provides internet services so it's an ISP*); completing a telephone call connection(col.6 lines 6-29); when the user selects Internet access(col.2 lines 7-10, col.3 lines 41-48, and col.19 lines 1-23): instruct a server to retrieve Internet content and deliver the Internet content to a translator(col.8 lines 16-24); instruct the translator to translate the Internet content to audio data and deliver the audio data to the conventional telephone(col.8 lines 16-24).

Uppaluru does not specifically teach prompting the user to select between a voice call and Internet access and determining the user selects voice call or internet access.

In the same field of endeavor, Enzmann teaches prompting the user to select between a voice call and Internet access upon receiving an incoming calling card call from the conventional

Art Unit: 2614

telephone and complete a telephone call connection when the user selects a voice call (Enzmann abstract, col.2 lines 6-17, col.7 lines 3-15, and col.10 lines 23-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system prompts of Uppaluru(col.9 lines 56-67 and col.15 lines 41-60) to initially include prompting the user to select between a voice call and internet access as obvious and further disclosed by Enzmann. Uppaluru's system already includes prompting the user and is able to determine selections so adding prompting the user to select between a voice call and internet access is an obvious design choice as Uppaluru's system is capable of making voice calls and accessing the internet. This would further provide access to telephony calls with the calling card so that Uppaluru's user can access both internet and regular voice calls via the same access card. This will also simplify billing since the user is charged for both services under one account. It is further noted that it is understood that the conventional home telephones coupled with the PSTN disclosed in Uppaluru col.6 lines 6-29 are able to complete telephone call connections.

Regarding claim 12, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is operable to receive the calling card call from a wire line telephone(Uppaluru col.6 lines 6-22).

Regarding claim 13, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is operable to receive the calling card call from a wireless telephone(Uppaluru col.6 lines 6-22).

Regarding claim 14 in view of Claim 5, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the translator translates text in XML format to audio data(Uppaluru col.8

lines 16-24).

Regarding claim 15, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is further operable to provide menu selections representing Internet content selections(Uppaluru col.2 lines 7-10, col.3 lines 41-48, and col.19 lines 1-23).

Regarding claim 16, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is further operable to receive IVR input representing Internet content selections(Uppaluru col.2 lines 7-10, col.3 lines 41-48, and col.19 lines 1-23).

Regarding claim 17, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is further operable to receive IVR input representing portal preferences and to communicate data representing the preferences to the portal server(Uppaluru abstract, col.8 lines 16-24 and col.19 lines 1-23).

Regarding claim 18, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is operable to receive IVR input wherein the IVR input is telephone key input(Uppaluru col.19 lines 6-7).

Regarding claim 19, Uppaluru in view of Enzmann teaches the system of Claim 22, wherein the IVR system is operable to receive IVR input wherein the IVR input is voice input(Uppaluru col.19 lines 6-7).

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph T. Phan whose telephone number is (571) 272-7544. The examiner can normally be reached on Mon-Fri 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/633,356
Art Unit: 2614

Page 10

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